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|---|------------------------|---------------------|--|
| Examiner-Initiated Interview Summary | Application No. | Applicant(s) | |
| | 09/424,544 | INO ET AL. | |
| | Examiner | Art Unit | |
| | Jeff Piziali | 2673 | |

All Participants:

Status of Application: Non-Compliant Appeal Brief

(1) Jeff Piziali.

(3) _____

(2) Brian Dutton (Registration Number 47,255).

(4) _____

Date of Interview: 3 November 2005

Time: _____

Type of Interview:

- ☒ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☒ No
 If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

3, 5-7, 11, 13-20, 23-29, 31, 37, and 43-48

Claims discussed:

3, 5, 7, 11, 13-20, and 23-24

Prior art documents discussed:

Takeda et al (US 4,825,203)


Part II.


SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

See Continuation Sheet

Part III.

- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.


BIPIN SHALWALA
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 2600


 (Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature – if appropriate)

Continuation of Substance of Interview including description of the general nature of what was discussed:

The examiner made a telephone call to Mr. Brian Dutton (Registration Number 47,255), leaving a voice message on 3 November 2005. Mr. Dutton kindly responded to this voice message later in the day, and an impromptu interview transpired -- the subject of which is summarized below.

The examiner explained that after analyzing the Appeal Brief filed 29 October 2004, and following a consultation with a Training Quality Assurance Specialist, it appears as though the brief is non-compliant under 37 CFR 41.37. Mr. Dutton at first contended the appeal brief had not been filed under 37 CFR 41.37. However, after being directed to page 1 of the brief -- which states, "This is an Appeal Brief under 37 C.F.R. 41.37 appealing the final decision of the Examiner dated November 4, 2003" -- Mr. Dutton agreed the brief had indeed been filed under the rules established by 37 CFR 41.37.

The examiner then directed Mr. Dutton's attention to page 11 of the brief, which reads, "While not conceding the propriety of these rejections, and in order to further the prosecution of the application, claims 3, 5, 7, 11, 13-20 and 23-24 attempts (sic) have been made within the above-noted Amendments After Final Rejection Under 37 C.F.R. 1.116 to cancel these claims without prejudice or disclaimer of their underlying subject matter, rendering the rejection moot as to these claims." The examiner asked if the 35 USC 102(b) grounds of rejection (via Takeda et al (US 4,825,203)) of the aforementioned claims were actually argued anywhere in the brief.

Mr. Dutton responded by challenging the examiner's refusal to enter certain previous after-final amendments, which would have canceled the claims in question. The examiner explained again (as explained previously in earlier Advisory Actions), that those particular after-final amendments had not been entered due to their inclusion of new issues and/or the improper addition of new claims -- all of which would have required more search and consideration at the time.

Mr. Dutton expressed frustration at the year-long processing delay of this appeal brief. The examiner did and does apologize for this delay. However, the examiner explained that the digital conversion of Patent Office paper applications into a fully electronic database form over the past year (completely outside the examiner's hands) was responsible for this delay.

Mr. Dutton then asked the examiner to consider the arguments provided in the brief, as they pertain to other appealed claims (other than claims 3, 5, 7, 11, 13-20 and 23-24). The examiner explained that he would be fully willing to respond to all the brief's arguments; but first the brief must be clear about which claims are actually being appealed and exactly specify what grounds of rejection are being argued.

At this point, Mr. Dutton declared that the brief does indeed provide an argument with respect to the grounds of rejection of claims 3, 5, 7, 11, 13-20 and 23-24. When the examiner requested a location in the brief for such arguments, Mr. Dutton pointed back again to the fourth paragraph on page 11 of the brief. The examiner could still find no argument(s) pertaining to the 35 USC 102(b) grounds of rejection in this location. As such, the examiner explained that mailing an official notification of non-compliant appeal brief would be necessary.

Mr. Dutton requested that the examiner seek an additional pair of eyes, for a secondary expert opinion on the matter. The examiner assured Mr. Dutton that multiple senior Patent Office officials have been consulted regarding this matter of appeal brief non-compliance.